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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/588,495	06/07/2000	Akihito Mochizuki	1232-4423US1	9609

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Morgan & Finnegan LLP
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EXAMINER

BAROT, BHARAT

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 07/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/588,495

Applicant(s)
Akihito Mochizuki

Examiner
Bharat Barot

Art Unit
2154



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jun 7, 2000
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-12 and 15-20 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-12 and 15-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/025,184.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 03 6) ☐ Other:

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DETAILED ACTION

Specification

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

2. The abstract of the disclosure is objected to because the provided abstract does not contain the proper language and format for an abstract of the disclosure.

Appropriate correction is required. See MPEP § 608.01(b).

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 250 words. It is important that the abstract not exceed 250 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

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Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 8-12 and 15-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Toyada et al (U.S. Patent No. 5,812,278). Toyada (5,812,278)'s patent meets all the limitations for claims 8-12 and 15-16 recited in the claimed invention.

6. As to claim 8, Toyada (5,812,278) discloses a data communication apparatus comprising : first transmission means for transmitting data representing existence of additional information to a transmission destination; reception means for receiving a reply from the transmission destination for the data transmitted by the first transmission means; and second transmission means for transmitting the additional information on the basis of the reply received by the reception means (figures 21-22; and column 20 line 53 to column 21 line 59).

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7. As to claims 9-10, Toyada (5,812,278) discloses that the second transmission means transmits the additional information in a manner different from that of the first transmission means and to a terminal different from a terminal to which the data was transmitted by the first transmission means (figures 21-22; and column 20 line 53 to column 21 line 59).

8. As to claim 11, Toyada (5,812,278) discloses a link to a location of the additional information is set in the data transmitted by said first transmission means (figure 22; and column 21 lines 18-59).

9. As to claim 12, Toyada (5,812,278) discloses a processed content based on the reply received by the reception means is further transmitted to the transmission destination (figures 22-24; and column 21 line 18 to column 23 line 4).

10. As to claims 15-16, they are also rejected for the same reasons set forth to rejecting claim 8 above, since claim 15 is merely a method of operation and claim 16 is merely a computer readable medium for the apparatus defined in the apparatus claim 8.

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Claim Rejections - 35 USC § 103(a)

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toyada et al (U.S. Patent No. 5,881,233) in view of Toyada et al (U.S. Patent No. 5,812,278).

13. As to claim 17, Toyada (5,881,233) teaches a data communication method comprising the steps of : recognizing a received e-mail; and instructing a transmission source of the e-mail recognized in the recognition step, to transmit image data in a method other than the e-mail so as to process the image data (figures 3-4 and 24-27; column 1 lines 50-58; column 2 line 61 to column 3 line 25; column 7 line 1 to column 8 line 10; and columns 20-23).

Toyada (5,881,233) does not explicitly teaches a step of :displaying an image for display on the basis of a content recognized in the recognition step.

Toyada (5,812,278) explicitly teaches a step of :displaying an image for display on the basis of a content recognized in the recognition step (figures 12 and 19-20; column 16 lines 15-45; and column 19 line 51 to column 20 line 52).

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Toyada (5,812,278) in the data communication method of Toyada (5,881,233) because doing so would proved improved control on the data communication method for transmitting and receiving image data.

14. As to claims 18-19, Toyada (5,881,233) discloses that in the instruction step it is instructed to print the image and store the image data (see abstract; figures 1-4; and column 5 line 25 to column 8 line 10).

15. As to claim 20, it is also rejected for the same reasons set forth to rejecting claim 17 above, since claim 20 is merely a computer readable medium for the method of operation defined in the method claim 17.

Additional References

16. The following references are cited by the examiner as of general interest.

- a.** Brouwer et al, U.S. Patent No. 5,841,982.
- b.** Ishizaki et al, U.S. Patent No. 5,841,977.

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Contact Information

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Bharat Barot** whose telephone number is **(703) 305-4092**. The examiner can normally be reached on Monday-Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **An, Meng-Ai**, can be reached at **(703) 305-9678**. The fax phone numbers for examiner's Art Unit OR Group are **After final response (703) 746-7238, Official response (703) 746-7239, and Unofficial/Draft response (703) 746-7240**.

Any inquiry of general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is **(703) 305-3900**.

Patent Examiner Bharat Barot

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July 10, 2003

Bharat Barot

**BHARAT BAROT
PRIMARY EXAMINER**